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PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

40985/DMC/C685

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on November 16, 2005

Signature

Typed or printed name Renne M.F. Wyzykowski

Application Number

09/699,031

Filed

October 27, 2000

First Named Inventor

Michael Obradovich

Art Unit

2162

Examiner

Baoquoc N. To

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

attorney or agent of record. 41,661
Registration number _____

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

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November 16, 2005

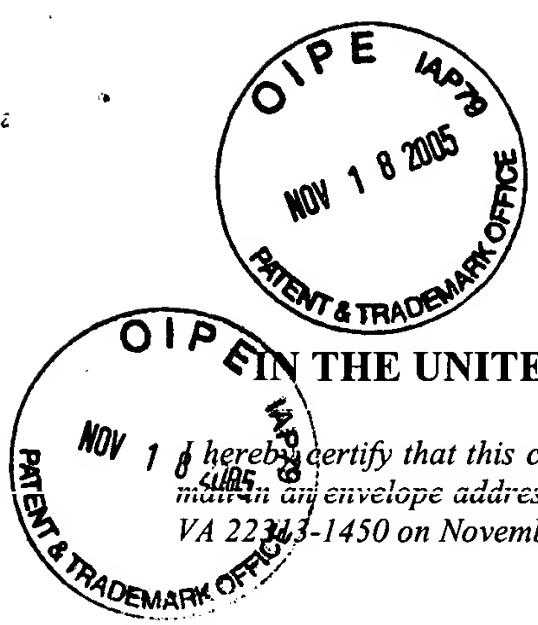
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

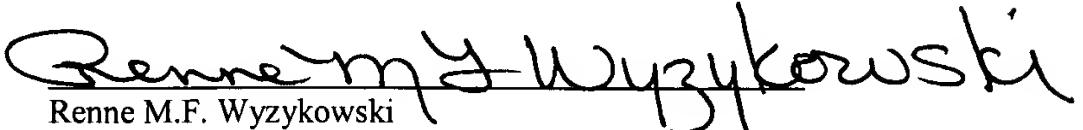
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Renne M.F. Wyzykowski

Appl No. : 09/699,031 Confirmation No. 6778
Applicant : Michael Obradovich
Filed : October 27, 2000
Title : SYSTEM AND METHOD FOR USER NAVIGATION

TC/A.U. : 2162
Examiner : Baoquoc N. To

Docket No. : 40985/DMC/C685
Customer No. : 23363

**ARGUMENTS ACCOMPANYING PRE-APPEAL BRIEF
REQUEST FOR REVIEW**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
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Post Office Box 7068
Pasadena, CA 91109-7068
November 16, 2005

Commissioner:

Applicant is filing this paper concurrently with a Pre-Appeal Brief Request for Review (form PTO/SB/33) and a Notice of Appeal. For the reasons set forth below, Applicant submits that the Examiner has not established a clear *prima facie* case in rejecting claims 1, 2 and 26-29. Applicant is not requesting pre-appeal review of rejected claims 22-25 with this paper.

Claims 1-2 and 26-29 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over DeKock (U.S. Patent No. 6,466,862) in view of Nakano (U.S. Patent No. 6,334,087). Claim 1 recites "requesting, by the personal computer device, that the server store the information in a database associated with a user of the personal computer." Applicant submits that DeKock and Nakano, whether considered individually or in combination, do not disclose or even suggest "requesting, by the personal computer device, that the server store the information in a database associated with a user of the personal computer."

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In response to the Office action dated December 22, 2004, Applicant presented detailed arguments at pages 8 and 9 of the response regarding a lack of any disclosure or suggestion in Nakano as to "requesting, by the personal computer device, that the server store the information in a database associated with a user of the personal computer." In the final Office action, however, the Examiner asserts that Nakano teaches at col. 22, lines 16-22, "requesting, by the personal computer device, that the server store the information in a database associated with a user of the personal computer." The portion of Nakano to which the Examiner refers states the following:

Alternatively, for example, the elements may be downloaded from the server side to be added to the elements stored in the mobile terminal side or to update the stored elements. Thus, the elements at the mobile terminal side are also added/updated according to addition/update of the map related information at the server side, and thereby it is possible to provide the latest, wide-ranging information.

Referring to FIGS. 1 and 2 of Nakano, the above-quoted portion of Nakano merely discloses that the map information storage portion 6 of the mobile terminal (see FIG. 1) is updated by the server (see FIG. 2) in accordance with any updates or new information in the databases 6-12 of the server. Accordingly, in contrast to the Examiner's assertion, the server does not receive any requests from the mobile terminal to store in the databases of the server any information associated with the user of the mobile terminal. Rather, the mobile terminal side downloads map information from the server. (See for example, col. 11, lines 40-44, col 12, line 66 to col. 13, line 6) Therefore, Nakano does not disclose or even suggest "requesting, by the personal computer device, that the server store the information in a database associated with a user of the personal computer."

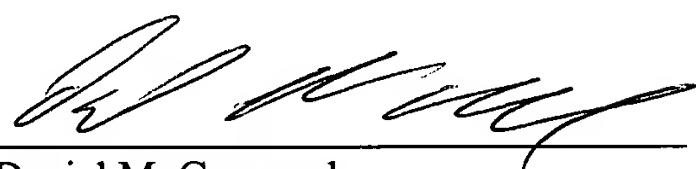
For the foregoing reasons, DeKock and Nakano, whether considered individually or in combination, do not disclose or even suggest "requesting, by the personal computer device, that the server store the information in a database associated with a user of the personal computer." Accordingly, the Examiner has not established a *prima facie* case in rejecting claim 1 under 35 U.S.C. § 103(a) based on a combination of DeKock and Nakano. Therefore, applicant submits

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that claim 1 is in condition for allowance. Claims 2 and 26-29 depend from claim 1 and hence are in condition for allowance.

Respectfully submitted,
CHRISTIE, PARKER & HALE, LLP

By



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